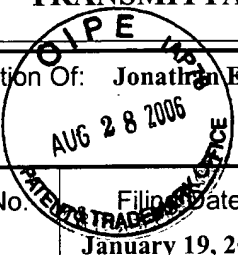


2204 AF

TRANSMITTAL OF APPEAL BRIEF (Large Entity)					Docket No. BAK.0011US	
In Re Application Of: Jonathan E. Lowthert, et al.						
Application No. 09/766,133	Filing Date January 19, 2001	Examiner Usha Raman	Customer No. 21906	Group Art Unit 2623	Confirmation No. 9485	
Invention: Content with Advertisement Information Segment						



COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on
June 23, 2006

The fee for filing this Appeal Brief is: **\$500.00**

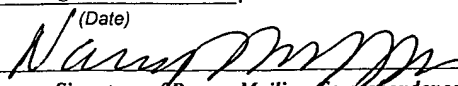
- ☒ A check in the amount of the fee is enclosed.
- ☐ The Director has already been authorized to charge fees in this application to a Deposit Account.
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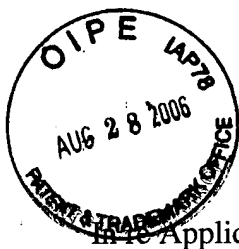

Signature

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Dated: **August 23, 2006**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant:

Jonathan E. Lowthert, et al.

Serial No.: 09/766,133

Filed: January 19, 2001

For: Content with Advertisement
Information Segment

Cust. No.: 21906

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Art Unit: 2623

Examiner: Usha Raman

Atty Docket: BKA.0011US

Conf. No.: 9485

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APPEAL BRIEF

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Nancy Meshkoff

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REAL PARTY IN INTEREST

The real party in interest is the assignee BlackArrow, Inc.

RELATED APPEALS AND INTERFERENCES

Appeals relating to this appeal, however tangentially, are as follows:

- In Application No. 09/561,443, an Appeal Brief was mailed on October 11, 2005, but prosecution was thereafter reopened.
- In Application No. 09/560,458 (now U.S. Patent No. 6,912,504) a decision on appeal was rendered for Appeal No. 2004-0992.
- In Application No. 09/690,159, an Appeal Brief was mailed on May 18, 2004, but prosecution was thereafter reopened.
- In Application No. 09/690,549, an Appeal Brief was mailed on February 27, 2006; no decision has been rendered yet.

STATUS OF CLAIMS

Claims 1-26 (Canceled).

Claims 27-34 (Rejected).

Claims 27-34 are rejected and are the subject of this Appeal Brief.

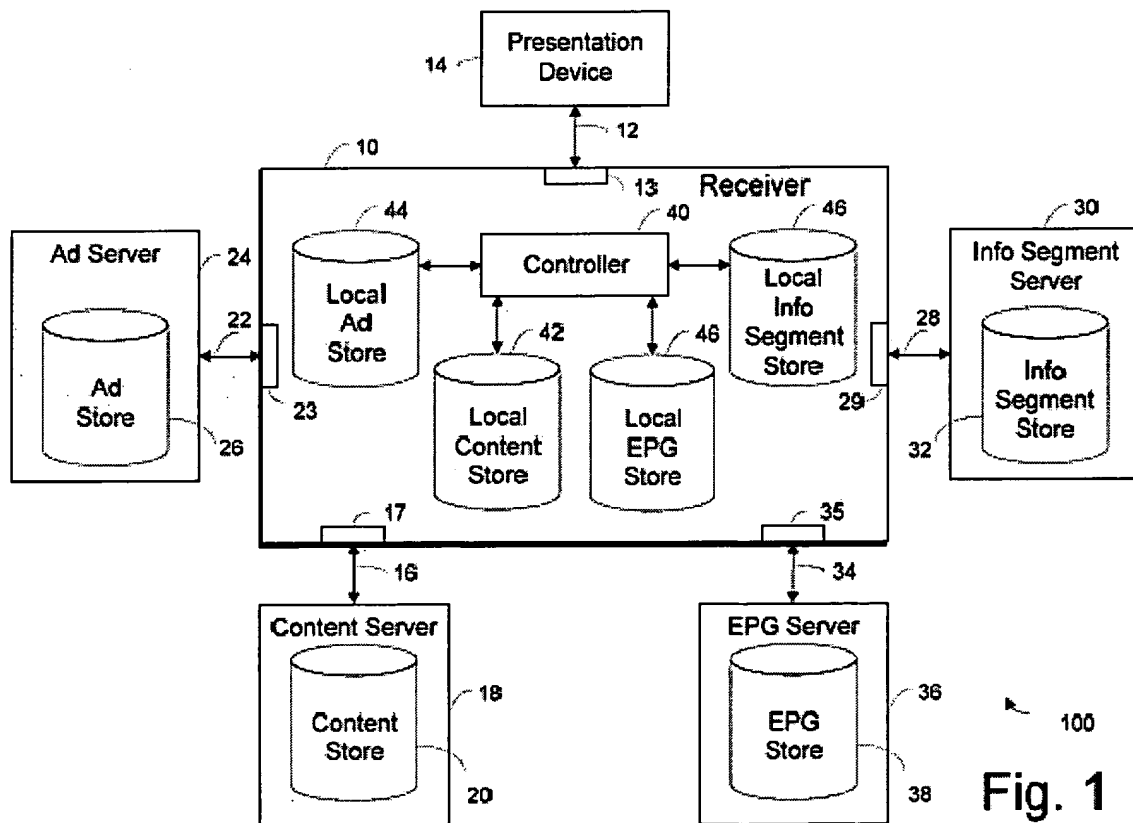
STATUS OF AMENDMENTS

All amendments have been entered.

SUMMARY OF CLAIMED SUBJECT MATTER

Claim 27 indicates that an interface identifies a content location and an advertisement to insert in the location, the interface identifies the location while the content is still stored in a cache. The third paragraph of claim 27 indicates that the interface is in a receiver and it utilizes an information segment to identify the content location while the content is still stored in the cache. The third paragraph of claim 27 also indicates that the interface uses the information segment to identify the advertisement for insertion in the location out of a plurality of advertisements.

In the following discussion, the independent claim is read on one of many possible embodiments without limiting the claims:



27. A system comprising:

a receiver to receive content with an information segment and a plurality of advertisements (Figure 1 at 10, Specification at page 3, line 29-page 5, line 6);

a cache, coupled to said receiver, to store said content with said information segment and advertisement (Figure 1 at 42, 44, 46; Specification at page 4, lines 25-31); and

an interface, in said receiver, to utilize said information segment to identify a content location and an advertisement, out of said plurality of advertisements, to insert in said location, said interface to utilize said information segment to identify said location while said content is still stored in said cache (Figure 1 at 40, Specification at page 6, lines 3-20).

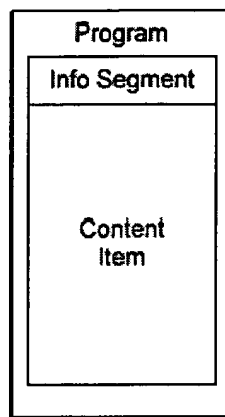


Fig. 2

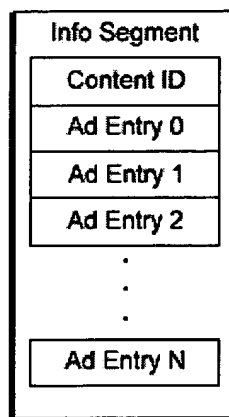


Fig. 3

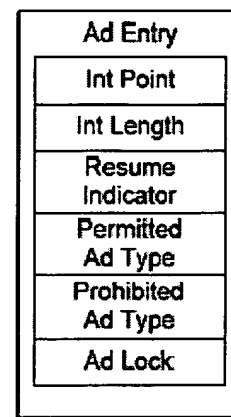


Fig. 4

29. The system of claim 27 wherein said interface to utilize an info segment having a plurality of fields, one field comprising an interruption point specifier to indicate a point to insert the advertisement in the content, another field selected from the group consisting of a maximum interruption length specifier, a resume indicator, a permitted ad type specifier, a prohibited ad type specifier, and an ad lock (*see, e.g.*, Figures 2, 3, and 4, Specification at page 5, line 7-page 7, line 27).

30. The system of claim 29 wherein said interface to utilize an info segment having an ad entry, said ad entry having said plurality of fields.

At this point, no issue has been raised that would suggest that the words in the claims have any meaning other than their ordinary meanings. Nothing in this section should be taken as an indication that any claim term has a meaning other than its ordinary meaning.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 27-34 are unpatentable over Zigmond.

ARGUMENT

A. Are claims 27-34 unpatentable over Zigmond?

1. Claims 27, 28, and 31-34

Independent claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond (U.S. Patent 6,698,020) alone. Claim 27 recites a receiver to receive content with an information segment and a plurality of advertisements, a cache coupled to the receiver, to store the content with the information segment and advertisement, and an interface, in the receiver, to utilize the information segment to identify a content location and an advertisement...to insert in the location, the interface to *utilize the information segment to identify the location while the content is still stored in the cache.*

To reject claim 27, the examiner cites to ad selection criteria 83 as disclosing an information segment. Paper No. 20060317, page 3. Ad selection criteria have nothing to do with identifying a location in content to insert an advertisement. Rather, Zigmond's ad selection criteria are merely used to select an advertisement. Column 11, lines 30-35. That ad selection criteria have nothing to do with identifying a location to insert an advertisement is evidenced by the examiner's rejection of claim 34. For example, in that rejection the examiner asserts that "the system discloses that location for insertion are identified by triggers." Paper No. 20060317, page 6. Therefore, in Zigmond triggers and not ad selection criteria allegedly teach identification of a location.

Triggers are not ad selection criteria. For example, Zigmond describes ad selection criteria as including advertising parameters and ad selection rules. Column 11, lines 30-47. He does not associate triggers with ad selection criteria. For example, the ad selection rules *are* delivered independent from the video programming feed and they *may be* delivered independent from the advertisement stream. Column 12, lines 1-32. But ad selection rules and preferably the advertisement parameters may be delivered on the advertisement delivery channel. *Id.* Regardless of how they are delivered, the ad selection criteria are stored on Zigmond's system 80.

In contrast, triggers are delivered with the programming feed, such as in the vertical blanking interval (VBI), and they prompt the video switch 90 to make an immediate switch as is explained below. Thus, triggers are not stored on Zigmond's system.

Furthermore, the ad selection criteria and triggers are independent of each other. Generally, Zigmond's system passively awaits the identification of a trigger in a streamed video before an advertisement can be displayed. Column 17, lines 24-32. The ad selection criteria do not have any information regarding when a trigger may occur and the triggers do not have any information as to why a particular advertisement is selected for a given program. Zigmond simply does not coordinate ad selection criteria and triggers, and triggers are not stored on a receiver. Thus, for this reason alone, the examiner's rejection fails.

Zigmond's triggers do not identify a content location (to insert an advertisement) while the content is still stored in a cache. For example, in one embodiment of Zigmond, advertisements are displayed when there is a conventional advertising slot in the programming feed. *See* Figures 2A and 2B. Thus, advertisements retrieved from an advertisement repository 88 can only be played during those predetermined time slots. Column 15, lines 34-65; column 16, lines 30-42. To know when to switch to display an advertisement, a switching decision unit 88 monitors a trigger delivery channel for a trigger. Column 15, lines 35-65. A trigger may appear in the video programming feed (such as in the VBI) at a pre-identified period of time before the onset of the subsequent advertisement series. *Id.* This pre-identified period of time is short as the switching decision unit 88 prompts the video switch 90 to interrupt the display of the video programming feed *when* the triggering signal is detected. *Id.* *See also* column 17, lines 21-32. Because the switching decision unit prompts the video switch to switch from the display of the video programming feed to display an advertisement from the repository *when* a trigger is detected, the feed has to be streamed to the video switch/switching decision unit to "find" the location in the stream corresponding to an advertising series. Accordingly, Zigmond does not identify a location to insert an advertisement until a program feed is streamed to the video switch, even if the feed originates from a VCR. More importantly, triggers are not stored by Zigmond; therefore, there is no way for a trigger to identify a content location for advertisement insertion while the content is stored in the cache. For this reason, Zigmond does not teach or suggest an information segment and an interface that uses the information segment to identify a location to insert an advertisement while the content is stored in the cache.

In another embodiment of Zigmond, advertisement insertion is independent of the predetermined position of conventional advertisement slots. Rather, a delay code is embedded in the programming feed that pauses the programming. Column 16, lines 30-40. Once

advertisements are complete, the paused programming resumes. *Id.* As Zigmond gives no way of detecting a delay code, presumably the switching decision unit, or something similar thereto, identifies the delay code. In other words, the mechanism for identifying a delay code is the same as identifying a trigger—the delay code embedded in the video programming is detected as the program is streamed through the video switch and switching decision unit such that *when* the delay code is detected, the video switch pauses the streaming video upon identification. Clearly, the video programming is streaming when the delay code is identified. Moreover, Zigmond simply does not disclose storing a delay code. For these additional reasons, Zigmond does not teach an information segment that is utilized by an interface to identify a content location to insert an advertisement in the location where the content location is identified while the content is still stored in the cache.

Thus, regardless of whether a triggering event in Zigmond is a delay code or a trigger in the VBI of a television signal, *when the triggering event is received*, the video switch is *activated* to interrupt the display of the video programming feed. Column 17, lines 24-31. There is no suggestion within Zigmond to store a trigger or delay code with content and an advertisement in a cache, or to use the trigger or delay code to identify a content location to insert an advertisement, the identification of the content location while the content is stored in the cache. Reversal of the rejection is requested.

2. Claims 29 and 30

Claim 29 recites the interface to utilize an info segment having a plurality of fields, one field comprising an interruption point specifier to indicate a point to insert the advertisement in the content, another field selected from the group consisting of a maximum interruption length specifier, a resume indicator, a permitted ad type specifier, a prohibited ad type specifier, and an ad lock.

As explained above in section A1 of this Brief, Zigmond's ad selection criteria fails to include an interruption point specifier, therefore the ad selection criteria does not disclose or suggest the claimed information segment. Rather, the only way it is known in Zigmond to interrupt the display of the video feed is to detect a triggering event or a delay code in the video programming feed. There is nothing in Zigmond that teaches that a trigger has a plurality of fields with one field comprising an interruption point specifier and another field such as a permitted ad type specifier.

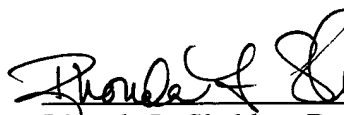
Indeed, the examiner cites to content ratings as disclosing a prohibited ad type specifier. But a content rating is an ad selection criterion. Because there is nothing in Zigmond that points to a known relationship between a triggering event and the ad selection criteria, Zigmond does not disclose an information segment having a plurality of fields with one field comprising an interruption point specifier. In other words, the triggering event is found solely in the programming feed and it provides no information with respect to what advertisements should be inserted or why. This information is contained within the ad selection criteria. But the ad selection criteria have no idea when a triggering event will occur—Zigmond's system must passively wait for the identification of a trigger before an advertisement is delivered to the video switch. Because Zigmond does not disclose or suggest an info segment having a plurality of fields, with one of the field being an interruption point specifier and another, different field, reversal of the rejections is requested.

Conclusion

Applicant respectfully requests that each of the final rejections be reversed and that the claims subject to this Appeal be allowed to issue.

Respectfully submitted,

Date: August 23, 2006


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CLAIMS APPENDIX

The claims on appeal are:

27. A system comprising:
 - a receiver to receive content with an information segment and a plurality of advertisements;
 - a cache, coupled to said receiver, to store said content with said information segment and advertisement; and
 - an interface, in said receiver, to utilize said information segment to identify a content location and an advertisement, out of said plurality of advertisements, to insert in said location, said interface to utilize said information segment to identify said location while said content is still stored in said cache.
28. The system of claim 27 wherein said interface to utilize an info segment with an interruption point specifier to indicate a point to insert the advertisement in the content.
29. The system of claim 27 wherein said interface to utilize an info segment having a plurality of fields, one field comprising an interruption point specifier to indicate a point to insert the advertisement in the content, another field selected from the group consisting of a maximum interruption length specifier, a resume indicator, a permitted ad type specifier, a prohibited ad type specifier, and an ad lock.
30. The system of claim 29 wherein said interface to utilize an info segment having an ad entry, said ad entry having said plurality of fields.
31. The system of claim 27 wherein said cache stores an electronic programming guide having a program identifier and an associated info segment, said electronic programming guide to enable locating the info segment corresponding to a selected program.
32. The system of claim 27 wherein said system is a television receiver.

33. The system of claim 27 wherein said system is connected to a presentation device through a wireless connection.

34. The system of claim 27 wherein said location is where the sound volume goes to zero.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

Appeal No. 2004-0992, decision on the following pages.

PIL

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

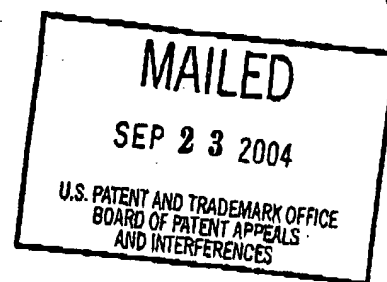
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OLEG B. RASHKOVSKIY

Appeal No. 2004-0992
Application No. 09/560,458

ON BRIEF



Before KRASS, RUGGIERO and BLANKENSHIP, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 2-7 and 9-26.

The invention pertains to the distribution of television advertisements over the Internet.

Mail Date _____
Due Date _____
Act. Req. _____

TPHD ☒ TPHA ☐ ITLD ☐

Appeal No. 2004-0992
Application No. 09/560,458

Representative independent claim 15 is reproduced as follows:

15. A method comprising:

determining whether a client is configured to automatically display advertizing material in association with other content; and
providing through a server access to the other content.

The examiner relies on the following reference:

Hidary et al. (Hidary) 5,774,664 Jun. 30, 1998

Claims 2-7 and 9-26 stand rejected under 35 U.S.C. 103 as unpatentable over Hidary.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

At the outset, we note that contrary to appellant's indication, there is no issue before us involving a rejection under 35 U.S.C. 102. The sole issue before us on appeal is the obviousness of the claimed subject matter under 35 U.S.C. 103.

It is the examiner's position, with regard to claims 2-4, 6, 7 and 9-14, that Hidary discloses detecting an event comprising comparing the time of day, which reads on the current time, to the time that advertising is to be distributed (column 3, lines 47-49); viewing an advertisement distributed over a TV

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distribution system (column 2, lines 37-38), which reads on automatically accessing an advertisement distributed over a first medium; accessing content over the Internet, which reads on a second medium, and displaying the advertisement in association with the content from the second medium (column 3, lines 45-49).

The examiner indicates that Hidary does not teach interrupting the content to display the advertisement and does not teach inserting advertising material. However, the examiner alleges that this is the "common mode" (answer-page 4) for combining advertising with content in commercial television broadcasting. Accordingly, the examiner concludes that it would have been obvious to interrupt the content to display the advertising.

With regard to claim 5, the examiner alleges that Hidary teaches accessing the advertisement at a certain period of time (column 5, line 66 through column 6, line 3) and that this reads on accessing the advertisement in response to an elapsed period of time.

With regard to claims 15-26, the examiner alleges that Hidary teaches providing through a server 28 access to other content (column 5, lines 39-44) and automatically displaying

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advertising material with the content (column 2, lines 34-35 and column 3, lines 34-36).

While the examiner indicates that Hidary does not explicitly teach determining whether a client is configured to automatically display advertising material in association with other content, the examiner contends that Hidary "necessarily" performs the method claim and that, therefore, Hidary inherently discloses the claimed subject matter (see page 5 of the answer). In order to show the inherency alleged, the examiner notes that it is necessary to determine whether a client is configured to automatically display advertising material in association with other content before the advertising material is automatically displayed in association with other content. The examiner indicates that the reference teaches, at column 3, lines 37-40, that any standard PC is physically configured to implement the reference invention, and that information is provided regarding when the advertising material is to be distributed over the first medium, at column 3, lines 45-49.

With regard to claims 2-7 and 9-14, appellant argues that Hidary does not interrupt content accessed from one medium to display an advertisement that is accessed and distributed over a

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different medium and that there is no motivation for modifying Hidary to provide for such.

We agree with appellant.

Each of claims 2-7 and 9-14 requires accessing an advertisement distributed over a first medium, accessing content from a second medium and interrupting the content and displaying the advertisement. It is clear that Hidary does disclose two mediums, a TV broadcast, and the Internet, whereby content is accessed from one medium and advertisements are accessed from the other medium. But, Hidary displays the content simultaneously with the advertisement material, rather than interrupting the content and displaying the advertisement.

The examiner recognizes this deficiency in Hidary but contends that it would have been obvious to display the advertisement by interrupting the content in view of the old and well known technique, in broadcast TV, of interrupting the content of a television program by commercials, i.e., advertisements.

We agree that it was well known, in commercial TV, to interrupt program content for permitting advertisements. However, in such cases, the advertisement and the program content both emanate from the same medium, rather than two different

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mediums, as required by the instant claims. It is true that Hidary shows two different mediums for presenting the content and the advertisement, but there does not appear to be any reason for the artisan to have modified Hidary to provide for an interruption of the content in order to display the advertisement.

Hidary recognized the old broadcast TV method of interrupting programs to display advertisements. This is apparent throughout Hidary's disclosure as, for example, at column 2, lines 62-64, wherein it is disclosed that

advertisers can speak more directly to consumers by directly sending Web pages to the consumer instead of only displaying Web addresses in their commercials; and consumers can gain a new level of interest and interactivity over a video-based medium.

Thus, it is clear that Hidary wants to get away from the mere watching of TV commercials which interrupt regular broadcast TV programs and wants to involve viewers interactively. This is why Hidary provides for simultaneous display of content and advertisement. Accordingly, it would appear contrary to Hidary's teachings to merely interrupt a broadcast TV program with the display of an advertisement, rather than the simultaneous display of both. Accordingly, we find that the skilled artisan would not have been led to modify Hidary in such a way to interrupt the

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broadcast TV program content in order to provide for an advertisement from a different medium. The display of an advertisement alongside content is not an "interruption" of the content, as required by the instant claims.

Therefore, we will not sustain the rejection of claims 2-7 and 9-14 under 35 U.S.C. 103.

We reach the opposite result with regard to claims 15-26 and we will sustain the rejection of claims 15-26 under 35 U.S.C. 103.

With regard to claims 15-26, appellant argues that the examiner relies on inherency for the rejection of these claims. This is true. The examiner does find it inherent in Hiday to determine whether a client is configured to automatically display advertising material in association with other content. The examiner explains that it is necessary to determine whether a client is configured to automatically display advertising material in association with other content before the advertising material is automatically displayed in association with other content.

Appellant does not argue, in any meaningful way, the merits of the examiner's position that in order to automatically display advertising material, a client must, of necessity, be configured

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to display such material. Instead, appellant argues that the examiner's inherency argument points to a rejection under 35 U.S.C. 102, rather than a rejection under 35 U.S.C. 103 (see page 7 of the reply brief).

This argument is not persuasive because even if the examiner could have made the rejection under 35 U.S.C. 102, rather than under 35 U.S.C. 103, anticipation is the epitome of obviousness. In re Fracalossi, 681 F.2d 792, 215 USPQ 569 (CCPA 1982).

The examiner's position that in order for something to be displayed, a system must be configured to display it, is so reasonable to us that appellant must provide some reason why this would not be the case. Appellant's mere assertion, at page 8 of the reply brief, that the examiner has not shown that Hidary must function or perform in the claimed manner, does not, in our view, overcome the examiner's reasonable assertion of inherency, in view of the rather broad scope of the instant claims. For example, independent claim 15 merely requires a determination of whether a client is configured to automatically insert and display advertising material in association with other content; and providing through a server access to the other content. Clearly, Hidary provides access to content through the Internet via a server. Further, Hidary provides for the display of

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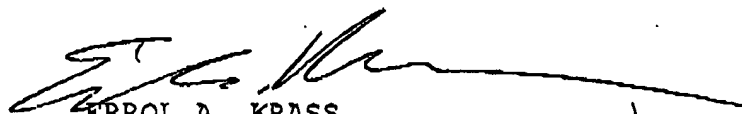
advertising material in association with the other content. If
Hidary displays advertising material in association with other
content, then the client performing this function must, of
necessity, be "configured" to do so.

We have sustained the rejection of claims 15-26 under
35 U.S.C. 103 but we have not sustained the rejection of claims
2-7 and 9-14 under 35 U.S.C. 103.

Accordingly, the examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART



ERROL A. KRASS
Administrative Patent Judge



JOSEPH F. RUGGIERO
Administrative Patent Judge



HOWARD B. BLANKENSHIP
Administrative Patent Judge

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Appeal No. 2004-0992
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